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10/063,990	05/31/2002	Scott Wolmuth	001-025	3829

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EXAMINER
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NGUYEN, QUYNH H

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/063,990

Applicant(s)

WOLMUTH, SCOTT

Examiner

Quynh H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 3-4, 9, 11-12, and 16 are objected to because of the following informalities:

Claims 1, 9, and 16, line 1, "comprising;" should be -- comprising: --.

Claims 3-4 and 11-12, line 2 "User's" should be -- User's --.

Claim 1 recites the limitation "A system in which an advertisement is played to a user comprising; using a selection means using selection criteria to select said advertisement" that use method steps language in an apparatus claim. Suggested phrase is -- A system in which an advertisement is played to a user comprising: a selection means for using selection criteria to select said advertisement --. For the purposes of examining, the claims will be interpreted as suggested above.

Claim 9 recites the limitation "A system in which an advertisement is played to a user comprising; providing directory assistance to the users; and using a selection means using selection criteria to select said advertisement" that use method steps language in an apparatus claim. Suggested phrase is -- A system in which an advertisement is played to a user comprising: a directory assistance to users, and a selection means for using selection criteria to select said advertisement --. For the purposes of examining, the claims will be interpreted as suggested above.

Claim 16 recites "A device for the providing of directory assistance comprising;" as the preamble that has no direct link or related to the body of the claim. Therefore, it

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will not be considered for patentability weight or evaluation. For the purposes of examining, the claims will be interpreted as follow:

A system for providing directory assistance to a user connecting to said system in a telephone network comprising:

a memory means for containing a plurality of advertisements; and

a processing means for using a selection criteria to select an advertisement;

wherein said system playing said advertisement to said user.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-9, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent 4,850,007) in view of Gregorek et al. (U.S. Patent 5,557,658).

**As to claim 1**, Marino et al. teach a system (*Fig. 1, advertising message system 13*) in which an advertisement (*advertising messages*) is played to a user (*Fig. 1, local telephone customer*) (col. 1, lines 44-49 and col. 2, lines 62-68).

Marino et al. do not teach a selection means for using selection criteria to select said advertisement.

Gregorek et al. teach a selection means (*Fig. 1, audible generator 14 and message generator 16 in the communications system 10*) for using selection criteria (*using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc*) to select said advertisement (col. 9, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made the feature of having a selection means for using selection criteria to select said advertisement, as taught by Gregorek, in Marino's advertising message system thus making the system more efficient by playing advertisements to the callers that tied to the callers' specific interests.

**As to claim 3**, Gregorek et al. teach the selection criteria is based on the user's geographical location (col. 9, lines 17-24).

**As to claim 4**, Gregorek et al. teach the selection criteria is based on the user's phone number (col. 9, lines 12-17).

**As to claims 5 and 8**, Marino et al. teach the user is requesting directory assistance and toll services (col. 1, lines 39-44).

**As to claim 6**, Marino et al. do not teach selection means is a computer processor.

Gregorek et al. teach selection means (*audible generator 14 and message generator 16 in the communications system 10*) is a computer processor (Fig. 2, 100 and col. 9, lines 48-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate selection means is a computer processor, as taught

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by Gregorek, in Marino's advertising message system in order to select the type of advertisements which are to be played to the calling party prior transmitting the advertisements to the calling party, as discussed by Gregorek (col. 9, lines 5-7 and 48-52).

**As to claim 7**, Marino et al. teach advertisements are stored in a memory means (col. 4, lines 64-66).

**As to claim 9**, Marino et al. teach a system (*Fig. 1, advertising message system 13*) in which an advertisement (*advertising messages*) is played to a user (*Fig. 1 local telephone customer*) (col. 1, lines 44-49 and col. 2, lines 62-68) comprising:

a directory assistance to users (col. 1, lines 39-44).

Marino et al. do not teach a selection means for using selection criteria to select said advertisement.

Gregorek et al. teach a selection means (*Fig. 1, audible generator 14 and message generator 16 in the communications system 10*) for using selection criteria (*using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc*) to select said advertisement (col. 9, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made the feature of having a selection means for using selection criteria to select said advertisement, as taught by Gregorek, in Marino's advertising message system thus making the system more efficient by playing advertisements to the callers that tied to the callers' specific interests.

**As to claim 11**, the limitation of the claim is the same as the limitation of claim 3; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 3 above.

**As to claim 12**, the limitation of the claim is the same as the limitation of claim 4; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 4 above.

**As to claim 13**, the limitation of the claim is the same as the limitation of claim 6; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 6 above.

**As to claim 14**, the limitation of the claim is the same as the limitation of claim 7; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 7 above.

**As to claim 15**, the limitation of the claim is the same as the limitation of claim 8; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 8 above.

**As to claim 16**, Marino et al. teach a system (*Fig. 1, advertising message system 13*) for providing directory assistance to a user (col. 1, lines 39-44) connecting to said system in a telephone network (col. 2, lines 51-61) comprising:

a memory means for containing a plurality of advertisements (col. 4, lines 64-66); wherein said system playing said advertisement to said user (col. 1, lines 44-49 and col. 2, lines 62-68).

Marino et al. do not teach a processing means for using selection criteria to select said advertisement.

Gregorek et al. teach a processing means (*Fig. 1, audible generator 14 and message generator 16 in the communications system 10*) for using selection criteria (*using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc*) to select said advertisement (col. 9, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made the feature of having a selection means for using selection criteria to select said advertisement, as taught by Gregorek, in Marino's advertising message system thus making the system more efficient by playing advertisements to the callers that tied to the callers' specific interests.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent 4,850,007) in view of Gregorek et al. (U.S. Patent 5,557,658) and further in view of Swix et al. (U.S. Patent 6,718,551).

**As to claim 2**, Marino and Gregorek do not teach the selection criteria is based on Standard Industry codes.

Swix et al. teach selection criteria is based on Standard Industry codes (col. 3, lines 3-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the standard industry codes as being one of the section criteria, as taught by Swix, in Mario's and Gregorek's systems which indicate



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such user characteristics as employer and type of employer in order to deliver pertinent advertisements that the user would be interested in, as discussed by Swix (col. 3, lines 19-23).

**As to claim 10**, the limitation of the claim is the same as the limitation of claim 2; therefore, the claim is interpreted and rejected for the same reasons as set forth in claim 2 above.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Banks et al. (U.S. Patent 6,856,673) teach targeted advertising in a telephone dialing system.

Cohen et al. (U.S. Patent 6,385,308) teach telephone system and method for personalized announcements.

Kamel (U.S. Patent 6,212,262) teaches method of performing automatic sales transactions in an advertiser-sponsored telephone system.

Kamel (U.S. Patent 6,009,150) teaches call processing method for delivering promotional messages.

Kamel et al. (U.S. Patent 5,937,037) teach communications system for delivering promotional messages.

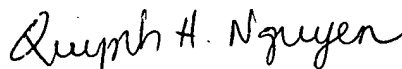
Mayer et al. (U.S. Patent 5,539,809) teach location specific messaging in a telecommunications network.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:15 A.M. to 4:45 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Quynh H. Nguyen**  
**Patent Examiner**  
**Art Unit 2642**